

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

REMARKS/ARGUMENTS

The examiner provided under the title “Claim interpretation” at page 2 of Action Letter at para 3, several contentious items which are responded as follows.

5

Firstly, to construe a claim element, its plain meaning is ascertained from the intrinsic record of the claims, the specification, and the prosecution history. Office personnel must rely on applicant’s disclosure to properly determine the meaning of the terms used in the claims. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d

10 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is meant by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” In re *Cruciferous Sprout* Litigation, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (emphasis in original) (citing *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed.Cir.1989)) Extrinsic evidence,
15 like dictionaries and treatises, is secondary, and expert testimony may be tertiary. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re *Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) See also In re *Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) (“Claims are not to be read in a vacuum, and limitations therein are
20 to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” 710 F.2d at 802, 218 USPQ at 292.

At Item B at page 2, the examiner provided the issue of using the word “for” in regards to Claim 34. Without admitting the examiner’s assertion, the applicant has amended
25 Claim 34 which is now without “for”.

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At Item D at page 3, the examiner stated “a database to transfer stored funds in claim 13 is being interpreted as a database having the ability to transfer stored, and not a database containing stored funds” (underlined mine). The applicant respectfully disagrees as the examiner provided nothing on record or by notice to reach such conclusion. Furthermore,
5 it is clearly stated in the specification that the database containing stored funds (for example see page 19 line 12-15 of specification) which is well within the understanding of one ordinarily skilled in the art. For example, in the banking art which uses a database to store funds for customers’ accounts. (See US PATENT 5659165)

10 At item E and F, the examiner provided In re Johnston, 77 USPQ2d 1788 (Fed Cir 2006) to give less patentable weight to the word “IF”. The applicant respectfully disagrees. In re Johnston does not support a per se rule of interpreting "if" or "when" as identifying an optional limitation. In re Johnston simply stands for the unremarkable proposition that if an element is optional, it need be given no weight. In the actual claim in In re Johnston,
15 the word "may" was used. Clearly as provided in MPEP 2144.04, there is no reason to conclude the facts in re Johnson is similar here.

An apparatus that has an element that makes a CONDITIONAL response to some stimulus is not an optional element. Similarly a method/process step that executes a conditioned response to an input is not optional. In this respect the examiner has failed to
20 show this is an optional limitation and furthermore, the suggested interpretation does not make sense and is not in line with the applicant’s specification. Furthermore, even in the prior art submitted by the examiner (ie US Patent 6424706 by Katz at Claim 1), it clearly shows “..;IF transfer of said unit minute.....” which is clearly accepted. However for the sake of expediting this examination, the applicant has cancelled the “if” to “upon
25 determining” where applicable but without admission the correctness of the examiner’s remarks.

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At item G, the examiner states that Independent Claims are examined together, since they are not patentable distinct. The only problem with this statement is that it ignores the fact that independent claims could have extra limitation that control its broadness or narrowness. As such if only the broad claim is examined without considering the extra element in the narrow claim, then this would be an examination failure on the part of the examiner. For example, in this application claim 48 is broader than Claim 13. However, these does not mean they are distinct and hence election/restriction is required. The requirements for election and restriction hinges on finding a serious burden on the examiner which could not be said given this application has gone through more than 6 examinations with 3 different examiners over the last 5 years.

At item H page 4, the applicant submits a provision here which is that Official Notices must be stated clearly by the examiner by words such as “Official Notice is taken.....” otherwise it is difficult to distinguish whether the examiner is making some remarks or personal opinion therefore failing to warn the applicant that indeed this is an Official Notice. Insofar as this Action Letter is concerned, the applicant could not find any express Official Notice being taken.

At item I page 4, the examiner states that since the word “database” is not lexicographically defined the USPTO will interpret the word accordance to Computer Dictionary. The applicant agrees that the word “database” is not defined in the specification but its usage is consistent with what is known in the art. However, does this mean one skilled in the art is not able to discern its plain meaning from the intrinsic record of the specification, and the prosecution history to date ? Office personnel must rely on applicant’s disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is meant by a word in a claim ‘is not to be

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confused with adding an extraneous limitation appearing in the specification, which is improper.” The examiner provided no reason as to the need to interpret the word with a dictionary. The examiner merely concluded that the applicant has not fully disclosed how a database is to transfer stored funds at the end, perhaps as a reason for wishing to interpret “database” ? (Page 5 of Action Letter). If the examiner wish to know how a database is to transfer stored funds then one need only to refer to page 19 line 12-15 (specification) specifically using a debit and credit process well known in the accounting art. Notwithstanding the above, the dictionary definition of database as provided the examiner includes “a file composed of records,....searching, sorting, recombining and other functions”. It is also well known in the art that records is well understood here to mean data representation of something (like funds) for each client and since these records can be search then payer and payee could be identify. In practice the actual debit/credit is written via SQL, a well known language for database programmers which the applicant submits is well within “other functions”.

As for Item J, without conceding, the applicant has amended “concerning” to be “related” to be consistent with other relationship in Claims 26,36,41.

Claim rejection under 35 USC 112 (1st Para)- lack of enablement requirement.

Referring to Para 5 at page 5, the examiner asserts that the applicant has not fully disclosed in the specification how a database in Claim 13,39 is to transfer stored funds and hence all other claims dependent on those above claims are rejected as well. It should be noted that the examiner did not reason why one skilled in the art of database programming and accounting will not be able to transfer funds stored in one account to another which the applicant submits is well within their knowledge. Obviously the

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examiner also did not define what skill is included in this ordinarily skilled artisan. This would be required at next office action.

As mentioned, the relevant knowledge is discussed in page 19 line 12-15 of the specification which combined with programming skills in SQL and double entry will
5 sufficient, unless the examiner could reason otherwise. One need only to consider that banks uses a database to store all its customer's accounts which requires transferring of funds from time to time. Even the prior art (Katz) in this action letter uses 2 databases to account for its customer's telecommunication units (not funds) which are then transfer from one account to another. Furthermore, the applicant respectfully submits even the
10 dictionary interpretation also includes "other functions" whereby the examiner fail to show these other functions do not include transfer in view of one skilled in the art of database and database programming. Finally, the applicant respectfully submit that all dependent claims could not be rejected as well based on the same reasoning alone, the examiner still has to reason from one skilled in the art to show it is so to establish prima
15 facie.

Claim rejection under 35 USC 112 (2nd Para)- indefinite requirement.

Referring to para 7, without conceding, the applicant has amended the term "concerning"
20 and hence such interpretation is not applicable.

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Claim rejection under 35 USC 102(e).

The examiner provided the prior art by Katz (US Patent 6424706) which relates to telecommunication-time (unit-minute) made transferable between subscribers and subscribers or non-subscribers. See abstract which states “A system and method for
5 accessing the value associated with a pre-purchased amount of telecommunication-time for making telephone calls and for uses other than making telephone calls is provided”.

There is no mentioned by Katz of transferring “stored funds”. The examiner fails to show telecommunication-time (unit-minute) is inherently found to be FUNDS to one skilled in the art of telecommunication. The applicant submits there is a clear division alluding to
10 this when Katz teaches having to convert the unit-minute to funds at a redemption office 202 or bank 221. If funds are the same as unit-minute then why is there a need to convert ?

It is also pertinent to note that Katz uses a prepaid CALLING card and not a prepaid card, the difference here is that a prepaid calling card is for making telephone calls while a
15 prepaid card is to make purchases. There is nothing in the specification dealing with telecommunication which enable one skilled in the art to read a prepaid card as a prepaid calling card and hence it would not be reasonable to read such property into its interpretation. Even if a prepaid card can be used to make a telephone call (ie as a calling card), it does not mean a prepaid calling card in Katz could be used for purchases unless
20 it is first converted to unit-minute and then converted to funds at office 202 or bank 221, a two stages process. In fact this is the essence of Katz’s invention which is to make use of unused prepaid unit-minutes for purchases or other services other than making a phone call but this is not the same as saying a prepaid calling card can be used as funds. Even if prepaid card is broad enough to include prepaid calling card (which is denied), the fact is
25 that in this claimed invention at claim 13,34,39 the key element is “said stored funds is deposited from a prepaid card” and as submitted above, a prepaid calling card in Katz is not capable of depositing funds as it could only provide unit-minutes for

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telecommunication. In Katz, funds are only recognized when unit-minutes leave the system and enter into some financial network or at the redemption office and not at the time of depositing.

5 Claim 13,34,39

The following Table A summarized the main differences between Katz and the claimed invention 13,34,39 as currently amended.

Items	Claimed Elements <u>Underlined</u> denotes currently added.	Katz	Comments
A	<u>a</u> host server having a database to transfer stored funds	uses a computer 343 having its own database 344 and a prepaid telco computer 172 also having its own database 173 of prepaid minute accounts stored. (See Fig 3A)	Katz's requires its unit-minute system 340 to interface with prepaid platform 170 each having their own computer cum databases. This means it needs 2 host servers (343,172) and 2 databases (173, 344).
B	said stored funds is deposited from a prepaid card <u>into an account linked to an user created identifier</u>	prepaid calling card or credit card or bank account are used to deposit	Katz's cards can only depositing unit-minutes not funds. No mentioned of user created identifier.

C	said transfer is made without interacting with said payee	In a preferred embodiment, after unit-minute transactions are completed, the system <u>notifies</u> both parties of the success of the transaction, and provides a unique transaction identifier that can be used for future reference and validation. (Col 8 line 48-50)	Transfer in claimed invention refers to stored funds not unit-minutes. Hence to recognize funds, the entire process from transfer unit-minutes and converting to funds in Katz has to be taken as a whole. This means in-between, after unit-minute is complete is taken as part of the entire transfer by providing a unique transaction identifier to payee to show ‘interacting’.
D	independently of said prepaid card	using a smart card adapter in association with wireless device or PDA (Col 21, line 50-55)	using the prepaid card as a storing value which is contrary to storing funds in database

Discussion on Item A of Table A

Fig 3A of Katz provides the entire system interconnection to satisfy a transfer of unit-minutes and linking to a financial network 223 and 365 to complete the conversion to funds. As noted, Katz provides United Minute System (UMS) 340 which is adapted to interface with prepaid platform 170. As taught by Katz the ‘transfer’ is done as explained at col 9 line 5 to line 25 and the applicant quotes “For instance, in a preferred embodiment, the present invention leverages existing prepaid minute accounts stored

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within a prepaid telephone platform, rather than replacing them with the invention's own minute accounts. Therefore, in order to perform the necessary unit-minute transactions, the unit-minute system must have read and write access to these accounts, and a converter for converting the existing prepaid minutes of the prepaid platform to the unit-minutes of the invention. Furthermore, any changes to data fields of the prepaid platform's minute account that are accessed by both the prepaid platform and unit-minute system must be made using a method that guarantees transactional integrity. Such access may be accomplished by integrating the transaction processing subsystem of the unit-minute system's computer system with the transaction processing subsystem of the prepaid platform by an adapter. Each system's transaction processing subsystem will in turn communicate with its respective database as needed to update any changed fields. Once the two systems are integrated in such a fashion, changes made by either system to such shared fields will be communicated to both systems in a transactionally safe and reliable fashion.”

The examiner provided item A and C at page 8 of Action Ltr as evidence. However, is clear from this teaching (Fig 3A) that more than one host (UMS 340 and Prepaid Platform 170) and more than one database (173 and 344) are needed to effect a transfer of unit-minutes. It is also clear that by itself UMS 340 cannot transfer any unit-minute as it depends on prepaid minutes from another database 173 to synchronize to its own database 344. This is clearly stated to be an advantage of the Katz's system having its own database as able to leverage (something like piggy-back) on the prepaid telco database instead of using one database as claimed. Therefore this teaching does not anticipate this claimed invention element of “host server having a database”.

Discussion on Item B of Table A

Katz teaches using a prepaid calling card to deposit unit-minutes or a credit card (col 6 line 33) or bank account (col 6 line 44). However, these facilities do not deposit funds

rather they are deposited as prepaid minutes in the prepaid platform 173 and unit-minutes in the database 344 of UMS 340 (See Fig 3A). It is well known that a telco must uses unit-minutes as a measurement of its service system and not funds. The main function of a telecommunication service provider is to provide telecommunication services and therefore its unit of measurement must be in minutes and not funds. The examiner provided at item G page 9 “The account is which funds are being transferred from is prepaid stored value account” and supported this by col 4, line 42 which also states “..such as telephone call minute accounts containing telecommunication-time units, over a network is provided”. It is submitted that because the examiner fails to show that a prepaid stored value account must necessary store funds in a telecommunication service provider, inherency is not found. Furthermore, if funds is stored, then this would contradicted the example given by Katz which clearly teaches one that stores telephone call minutes.

Discussion on Item C of Table A

As mentioned in Katz because the first stage of the transfer concerns unit-minutes, then it is necessary to redeem to money/funds. Katz clearly provides “transfer” to mean transferring of unit-minutes. For example, at Col 21, line 9-10, it is written “ Given the ability to transfer and redeem unit-minutes...”.

In reference to “said transfer is made without interacting with said payee” this is not meet by Katz as it is shown after a payer has transferred his unit-minute then the payee has to be notified (unique identifier) to redeem the converted unit-minutes using said unique identifier (Col 8 line 47-51) . This notification of said identifier for that transaction which requires interacting with a party obviously does not meet this claimed invention’s element in item C. If the payee is not a subscriber, then payer will have to inform them directly (col 19, line 34-40). The examiner in reply only shows “ The prior art invention makes an electronic funds transfer “ and provided col 8, lines 63-64. (See item H at page

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9) The evidence only shows Katz's invention is connected to financial networks such as ATM/POS, FedWire and CHIPS which is capable of making an electronic funds transfer but there is no evidence here to show without interacting with payee. In fact, these networks as shown ATM/POS (233) and Intrabank network (365) in Fig 3B would
5 require some interaction between the different member banks of the network which collectively are payers and payees on behalf of their customers such as in ACH or through SWIFT.

The examiner concluded by stating "therefore the actual transfer is made without any user
10 interaction and regardless of the origination of source funds". The applicant considers this conclusion to be limited to the financial network as opposed to Katz's telecommunication network which is not capable of transferring funds in view to "actual transfer" to denote transfer of funds. If this is the case then it should also be noted this claimed invention requires such transfer to be made "INSTANTLY" by crediting and debiting the
15 nominated accounts. It is well known that ACH/SWIFT/CHIPS (collectively financial network) is an overnight batch process (Col 10 line 10-15). The word "daily" would appear to be longer than instantly.

If the applicant is wrong (which is denied) and actual transfer is referencing transfer of
20 unit-minutes then it is clear Katz teaches interacting with payee as above and unit-minutes does not meet the requirement for transfer of funds.

As for redemption, even if these financial networks managed to avoid interacting with the final payee during the inter-bank transfer (ACH/SWIFT/CHIPS networks), it is crystal
25 clear that whenever there is a redemption it must necessary involve interacting with the payee since by definition, a redemption is an act done by said payee (For example see Fig

5A at BOX 504 providing redemption password to employee wherein password was from sender BOX 503). In Fig 6 where a subscriber is redeeming his own unit-minute (ie making himself both as payer and payee) via the financial network then it clearly shows him interacting by firstly inserting his ATM card.

- 5 Even if the applicant is wrong above (which is denied), the logical conclusion is that the examiner's sole reliance on these financial networks to show there is no interaction is selective reasoning which is unreasonable narrow as it ignores Katz's collective teaching. As mentioned by Katz, these financial networks interfaced with his telecommunication entities (not isolated) and his UMC to allow the redemption part of the process since cash
- 10 is needed. There could not be ANY transfer within the financial network had it not been the initial unit-minutes transfer first which in-between interacted by sending out notification (see col 8 line 48-50) and in order to convert them, said financial networks were chosen to cover the redemption of its unit-minutes. It is also undisputed that there is also interaction during redemption phase by the payee. So in totality, Katz taught
- 15 interaction and hence it is flawed to select only the financial network (which is part of the overall network) to reveal without interacting. Even if this could stand, such financial network is not able to satisfy the "instantly" element in effecting a transfer. Hence, either way it is clear if "transfer is made without interacting with said payee" and "funds" are met using the financial network alone, then "instantly" is not. On the other hand, if
- 20 "instantly" is met by using Katz's telecommunication database, then "transfer is made without interacting with said payee" and "funds" are not meet.

Discussion on Item D of Table A

- Katz merely discussed using a smart card adapter in alternative to a server-based design
- 25 as preferred embodiment. Therefore Katz teaching merely substantiates the difference to the claimed invention if used in lieu of the server-based design and hence fails to meet this element.

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Amendments

- 5 The current amendments include adding ‘a’ in front of host server in preamble and “into an account linked to an user created identifier” after whereby said stored fund is deposited from a prepaid card. These are NOT new matters as the addition of ‘a’ is merely for clarity to show its ONE host server while the latter is already shown in claims 48 and 49 (ie “whereby said account having a payer created identifier being different
- 10 from source of funds”) albeit a narrower context. The examiner did not address the account linked to an user created identifier and in Katz, it is clear that the subscriber is given a telephone number as the identifier (Col 7 line 6). It is submitted it is not known that this telephone number is an user created identifier.
- 15 In conclusion, given the above three items A,B,C are not found in Katz and contradicts item D (where a smart card is used), the applicant respectfully submits anticipation under 102(e) is not satisfied and the claims should be allowed.

Claims 14, 35,40

20

These claims deal with storing and linking card amount to an user account identifier. The examiner only made mentioned of “whereby upon completion of storing and linking said prepaid card is valueless” as page 9 item I. The examiner provided col 2 lines 25-26, which provides “First, subscriber 100 inputs their unique subscriber ID, which in the case

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of long distance prepaid systems is typically a temporary identifier, printed on the card itself and good until all of the minutes associated with the card are used up.”

Understandably this evidence is referring to long distance prepaid cards and the identifier
5 is good until all minutes associated with the card is used up which the applicant does not
dispute. However, how is this connected to storing and linking card amount to an user
account identifier which by the way is NOT a temporary identifier ? In this claimed
invention, a prepaid card having an amount and identifier is stored and linked to an user
account identifier which on completion, the said card is valueless and not using up the
10 minutes associated in long distance calls. The user creates his own identifier which
obviously has to be permanent to distinguish the identifier on the card.

Furthermore, the amount in this claimed invention the funds is stored by calculating its
face amount and linking it to user created identifier (NOT card identifier). At the end the
15 stored amount is still available but only through the user identifier and NOT card
identifier. Hence, the card is valueless. The applicant respectfully submits Katz fails to
teach this and hence the claims should be allowed.

No other rejections of the other elements in claims 14,35,40 were made by the examiner.
20 To anticipate ALL elements in the claims must be shown by the examiner which is not
performed in this instance and the applicant could only conclude this failure by the
examiner must mean the other elements are not found in Katz and hence 102(e) is not
made out.

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Claims 26, 36,41

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These claims deal with the calculation of the stored value to be provided. The examiner provided Katz teaching in part when unit-minutes are transfer to another in a different country which is later redeemed in said different currency (See Item J in page 9). In order words, the examiner wish the applicant to recognize that by showing that currency exchange is found in Katz, the prima facie anticipating the formula in claims 26,36,41 is made. No doubt currency exchange is an old art even without Katz but that does not mean the other elements in the formula are found in Katz or is known either. For example, storage period ? The examiner provided no rejection to the other elements and hence 102(e) is not made out. The applicant respectfully ask these claims to be allowed.

Claims 33,38,43

These claims state the payer is unknown to said host server. At first glance the applicant is unable to decipher whether the examiner has provided any rejection for this element. On second glance, the examiner noted in item B at page 8 with the words “ since the system only asks payer to enter ID and password, password true identity (name, address and birth date) is not known to the system in response to “prompting payer to input payer’s account identifier and password” element found in Claim 13,34,39.

With respect, this type of rejection is unclear and it appears to be a conclusion in reading col 17, lines 50-51 in Katz which states “If the caller ID information is not available in decision 402, a step 403 prompts the caller to input their subscriber ID and PIN.”

By way of a background, a telephony system usually provides caller ID on demand when a telephone is used but obviously this caller ID would not be available when the user provides a computer to access the system or any device that does not go through telephone exchange able to transmit this caller ID. That is the reason for Katz to teach asking for subscriber ID and PIN. However, does this mean by asking subscriber ID and

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PIN, the subscriber is unknown to the host server ? Note that subscriber ID is denoted as telephone number (Col 7 line 6)

The applicant would respectfully argued that since Katz uses a system that is integrated to prepaid telephony platform and have access to its database 173 (See Col 9 line 5 to line 25 and Fig 3A) and hence these subscribers in said database 344 are subscribers to said telephony platform 170, it is very unlikely that just because there is NO caller ID presence when initiating a transfer and subscriber ID is used in lieu, these subscribers are unknown to the telephony service provider 170. This is similar to suggesting the telephone company does not know its clients by their telephone numbers which is difficult to substantiate. The fact that a service is prepaid does not mean the telephone company does not ask for identification when opening an telephone account, nor is this a known practice.

Even non-subscribers will be allocated a temporary subscriber ID for a specific transaction. (See Col 7 line 29). Furthermore, when it comes to redeeming its unit-minute, Katz teach of the option of sending it to a bank account (Col 8 line 1-5) for payee. Surely, at this stage the UMS 340 must know to whom the money must be credited to based on the bank account information for unless it is also suggested that banks do not know who their customers are ? As far as ACH is concerned, the bank account must tally with the name of payer/payee or the transaction will fail. Therefore, the applicant respectfully submits that unless there is clear evidence to support the examiner's conclusion that a telco's database or its sidekick Katz database are inept in identifying its customers, then these claims must be allowed.

Claims 44,45,46

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These claims deals with issuance of a receipt representative a prepaid card having at least a serial number by a POS connected to said server. To clarify, these claims are directed to a user purchasing a prepaid card at POS and which also issues a receipt representative of said prepaid card. User therefore receives a receipt plus a prepaid card. This is in case the
5 user lost the prepaid card, he could still use it by referring to the receipt which bears a serial number connected to said prepaid card to cancel the card if the amount is still 'floating' (ie before storing it).

The examiner provided Item K & L at page 10 to show anticipation. The evidence in Katz
10 is suggested by the examiner to be found at Col 7, lines 63, col 8 lines 2 and 15 and col 19 lines 17-24.

To restate these evidence, the applicant quotes the whole paragraph encompassing col 7, line 63 to col 8 line 15 for completeness as follows: "In a preferred embodiment, the
15 system and method of the invention also provides a method for subscribers to access their "minute account" from any ATM or retail point-of-sale, POS terminal. In this method, the subscriber is issued a debit card associated with their prepaid minute account. This debit card is configured and functions in the same manner as traditional checking account based debit cards, except that in this case, withdrawals trigger a reduction of unit-minutes
20 equivalent to the value of withdrawal. Integration between the system and POS/ATM networks requires that the system and its associated corporate owner become a member bank within the financial network. Membership typically entails meeting certain network guidelines concerning credit worthiness and financial liquidity. In addition such memberships usually entail that the member becomes a governmentally registered and
25 regulated bank. In an embodiment where a non-financial network member implements the invention, it may be advantageous to partner with an existing financial network member. In this method of integration, the system's financial network interface would

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interface with the backend computer systems of the financial partner instead of directly with the financial networks.”

5 The applicant respectfully submits that the above only shows POS being accessed by a debit card to check minute account. There is nothing to show printing a receipt representative of a prepaid card.

10 As for Col 19 lines 17-24, this is stated as follows: “Once this has been determined, UMACH 370 will send a message via UMACH TP interface 371 to bank computer system 377 requesting that it issue appropriate payment requests, via interbank financial network 365, to all members who owe unit-minutes to UMACH 370 network. This payment request is in the form of the currency equivalent of the owed unit-minutes and is directed to be made to a UMACH settlement account 385.”

15 The examiner also reasoned “ Sending receipt to both the sender and receiver. This message may be sent in a number of formats.....facsimile message (Print) or text...., containing account/transaction ID”

20 It is clear the examiner is merely trying to combine two different stages in Katz, the first being to access minute account using a POS and the second UMACH performing a reconciliation between members unit minute accounts (similar to ACH). But there is no connection between accessing ones account using a POS and this UMACH trying to reconciled its books between its members. It also does not make any sense to bring the two to show a receipt having a serial number issued by a POS when purchasing a prepaid
25 card. This is purely words picking to show the existence of POS and receipts but this does not teach what is being claimed. The applicant respectfully ask the claims to be allowed.

Claims 48,49

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The examiner provided no mentioned directly to the elements found in both claimed invention.

In particularly, addition elements over claim 13,34,39 includes :

5

A. ...having a payer created identifier different from source of funds;

Bstored funds deposited without using a bank account;

Cwhereby payer and payee are two different persons.

10 As for A, the applicant submits that Katz fails to show this as the subscriber identifier being a phone number (Col 7 line 6) could not be created by subscriber himself.

As for B, the applicant submits that Katz teaches depositing using a bank account (Col 13 line 52, Col 15 line 55- Col 16 line 30). Katz also provides using a credit card to
15 purchase prepaid minutes. And even if all kind of funding facilities could be used including a prepaid calling card, one still must remember Katz teaches a telephony platform which must necessarily means its value must be stored as prepaid minutes and NOT stored funds.

20 As for C, Katz also teach subscriber redeeming the unit-minutes himself which means it could be the same payer and payee even though in general the applicant concedes, the payer subscriber and payee subscriber should be different persons.

Hence as far as A and B are concerned, the applicant submits Katz fails to show the
25 elements and hence 102(e) is not made out by the examiner. As mentioned previously in rebuttal labeled ‘Amendment’ for Claim 13,34,39, the examiner also failed to address the issue of payer created identifier different to the source. These claims also include “providing a host server having a database to transfer stored funds” as amended which

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

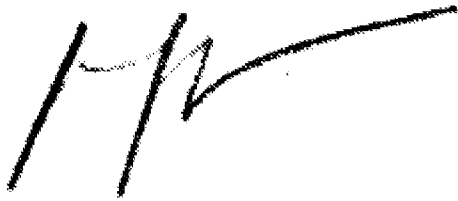
are discussed in claims 13,34,39 and not found in Katz. For the same reasons, these claims should be in allowance.

5 Claims 50,51,52

These claims have been amended to show that the prepaid card is a cash card. Obviously Katz fails to show this as it teaches a prepaid calling card to make telephone calls. It is also well known that a credit or debit cards are NOT cash card. Similarly, the applicant respectfully ask these claims to be allowed.

10

Thank you

A handwritten signature in black ink, appearing to be 'KH' followed by a long horizontal stroke.

Khai Kwan/Applicant 023336